

## REMARKS/ARGUMENTS

Claims 1-37 were pending at the time of the mailing of the outstanding Office Action. By this amendment, no claims have been added, cancelled or amended.

In the Office Action, the Examiner issued a request for information regarding the supplier of the metallic material utilized to construct the stent. This information is unknown at this time.

The Examiner rejected the pending claims under 35 U.S.C. § 103(a) as follows. Claims 1–17 and 19–35 stand rejected as being obvious over U.S. Pat. No. U.S. Patent No. 6,979,347 to Wu (hereinafter “Wu”). Claims 18 and 36–37 are rejected as being obvious over Wu in view of U.S. Patent No. 6,676,697 to Richter (hereinafter “Richter”).

Under *Graham v. John Deere Co.*, an obviousness determination under 35 U.S.C. 103 requires analysis of 4 factors:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Additionally, when applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

(MPEP § 2141, quoting *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).)

In reviewing the scope and contents of Wu, it is clear that the present invention is not taught or suggested in the cited prior art. While Wu does generally disclose the option of using a magnesium-based alloy in a stent, Wu makes no mention of any specific magnesium alloy. A virtually limitless number of alloys are theoretically encompassed by Wu's general disclosure of magnesium alloys. Therefore, the difference between Wu and claim 1 is the difference between a bare recitation of any magnesium alloy and a specific magnesium alloy containing > 90 percent magnesium, 3.7 - 5.5 percent yttrium, 1.5% - 4.4% rare earths and <1 percent other elements. Wu provides no teachings or suggestions regarding use of a composition containing yttrium in an endoprosthesis.

The Examiner cites U.S. Pat. No 4,401,621 to Unsworth (hereinafter "Unsworth") as showing that magnesium alloys such as those claimed, are known in the art. However, the Examiner has not relied on Unsworth in combination with Wu, but merely cites Unsworth as an example showing that such magnesium alloys are known in the art. However, it should be noted that Unsworth does not teach or suggest that such alloys may be useful in stents. Instead, Unsworth provides such alloys as being useful in aerospace applications (col. 1, lines 6-12) and accordingly tests the properties of the disclosed alloy at temperatures 200 °C and above, which are far outside the range of physiological temperature, 37 °C.

Neither Wu nor Unsworth teach or suggest that the claimed magnesium alloy composition would even be suitable for use in an endoprosthesis. First, such a material must be biocompatible generally. For example, regardless of any other properties provided by lead, mercury or other "heavy metals," these elements would obviously be incompatible with usage in an endoprosthesis. The Examiner provides no teaching or suggestion, either in the cited prior art or in the knowledge generally available to one of ordinary skill in the art, that yttrium is compatible with use in an endoprosthesis. It is likewise neither taught or suggested in the prior art that the use of such an alloy would provide advantageous properties such as prevention of

restenosis from sustained tissue growth prevention, a lack of inflammatory effect, and decomposition products which not only have no negative effect, but can actually have a positive effect (see paragraphs 0006 and 0009). Additionally, while Unsworth indicates that the a magnesium alloy provides good tensile properties, there is no indication that such an alloy would have other properties also required in an endoprosthesis such as torsional strength, minimization of re-stenosis, or minimization of inflammation.

Therefore considering the claimed invention and the references as a whole, there would be no suggestion to one of ordinary skill in the art to arrive at the claimed invention based on Wu alone or on Wu in combination with Unsworth. Withdrawal of the rejection of claims 1-17 and 19-35 under 35 U.S.C. § 103(a) is respectfully requested.

Claims 18 and 36-37 stand rejected as being obvious over Wu in view of Richter. As discussed above regarding Wu, Richter also does not provide a teaching or suggestion to add yttrium to a magnesium alloy for use in an endoprosthesis. Therefore, neither Wu nor Richter teach or suggest all of the claim limitations of claims 18, 36 and 37, which indirectly depend from claim 1. These claims also patentably distinguish over the cited prior art. Withdrawal of the rejection of claims 18, 36 and 37 under 35 U.S.C. § 103(a) is respectfully requested.

The outstanding Office action was mailed on 24 August 2007. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. This paper is timely filed without the payment of an extension fee on or before 26 November 2007, as the 3 month date for response, November 24, 2007, fell on a Saturday. Therefore, no extension of time or accompanying fee is believed to be due in making this response. Nevertheless, the Applicants hereby make a conditional petition for an extension of time for response in the event that such a petition is required. No fees are believed to be due with this response. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,

*/John J. Cunniff/*

Hahn Loeser & Parks LLP  
One GOJO Plaza, Suite 300  
Akron, OH 44311  
330-864-5550  
Fax 330-864-7986  
jcunniff@hahnlaw.com

John J. Cunniff  
Reg. No. 42,451  
Attorney for Applicants